

REMARKS

Claims 1, 3-4 and 6-9 are currently pending in the present application. Claims 1, 6, and 7 have been amended. Claim 2 has been cancelled and its limitation has been incorporated into claim 1. Claim 6 has been amended to correct a typographical error, support for which can be found at page 7, lines 3-32 of the application.

Applicants have carefully studied the outstanding Office Action. The present Response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of this application is respectfully requested. Applicants respectfully request reconsideration and withdrawal of the Examiner's rejections in view of the foregoing amendments and following remarks.

Claim Rejections -35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claimed ranges of hydroxyl number do not have any units. Hydroxyl number is not a dimensionless value. Typical hydroxyl number units are mg KOH/g.

Response

Applicants agree with and thank the Examiner for the opportunity to clarify claims 1 and 7 to include the correct units of the hydroxyl number. It is respectfully submitted that one skilled in the art, having read the specification, would recognize that the typically hydroxyl number units have been implemented in the subject application. In

light of the amendment, Applicants request reconsideration and withdrawal of the rejection under 35 U.S.C. 112, second paragraph.

Claim Rejections -35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6-9 have been rejected under 35 USC 102(b) as being anticipated by Hayakawa et al (WO96/34064) hereinafter all references are made to the English language equivalent US 6,689,839 B1) ("Hayakawa"). Examiner states:

Hayakawa et al discloses a thermoset paint composition comprising (a) a fluorine containing copolymer of fluoro-olefin, hydroxyl group containing vinyl based monomer and other vinyl based monomer having a hydroxy group value between 60 and 150 mgKOH/g [column 2 lines 34-39], (b) a vinyl based (co)polymer comprising a monomer represented by the general formula 1:

wherein $n = 0-10$ and the (co)polymer has a hydroxy group value between 60 and 150 mgKOH/g [column 2 lines 40-46; 55-60], and (d) a blocked polyisocyanate compounds [column 2 lines 49-50]. The hydroxyl group containing vinyl based monomer of component (a) may be lactone modified 2-hydroxyalkyl (meth)acrylate, e.g. ϵ -caprolactone modified 2-hydroxyethyl (meth)acrylate [column 4 lines 3-10]. The other vinyl based monomer of component (a) may be 2-hydroxyethyl (meth)acrylate [column 4 line 40] and monomers with a cyclic backbone such as cycloalkyl ester of (meth)acrylic acid [column 4 line 34], styrene [column 4 line 41], cyclohexyl vinyl ether [column 4 line 44], and combinations of two or more [column 4 line 46]. The monomer of component (b) represented by formula 1 is also a lactone modified vinyl based monomer such as modified 2-hydroxyalkyl (meth)acrylate, e.g. ϵ -caprolactone modified 2-hydroxyethyl (meth)acrylate [column 5 lines 54-63]. Since $n = 0-10$ in formula 1, there are between 0 and 10 caprolactone repetitive units in the lactone modified hydroxyalkyl (meth)acrylate. Other vinyl based monomers in component (b) include 2-hydroxyethyl (meth)acrylate [column 6 line 7] and monomer with a cyclic backbone including cycloalkyl ester of (meth)acrylic acid [column 6 line 1], styrene [column 6 line 7], and combinations of two or more [column 6 line 10-12]. Components (a) and (b) each read on both the claimed (meth)acrylic resin (A) of claim 1 and the lactone polyol (C) of claim 5.

Regarding claim 3, the disclosure of caprolactone modified 2-hydroxyethyl (meth)acrylate is considered the explicit disclosure of caprolactone modified 2-hydroethyl methacrylate and caprolactone modified 2-hydroxyethyl acrylate.

Regarding claim 4, example polymers AC-2 and AC-3 have cyclohexyl methacrylate in the monomer mixture in an amount of 10 weight percent and 5 weight percent, respectively [Table 2].

Regarding claim 6, all examples of lactone modified (meth)acrylic resins AC-1 through AC-5 have acid value below 30 mgKOH/g [Table 2].

Regarding claims 8 and 9, the blocked polyisocyanate compounds are capable of forming urethane bonds [column 3 lines 9-10; 23-24]. In order to form urethane bonds the isocyanate groups must be "liberated" from the blocking agent. Additionally, curing of the coating composition occurs at elevated temperature for an extended period of time [column 8 lines 59-63] indicating a process of "liberating" the isocyanate functional groups from the blocking agents.

Response

With regard to amended claim 1, Applicants respectfully submit that anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). A reference must "clearly and unequivocally disclosed the claimed compound or direct those skilled in the art to the compound with any need for picking, choosing, and combining various disclosures..." In *re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (CCPA 1972). The reference must provide a certain degree of precision with respect to the specific compound claimed. Hayakawa discloses a large laundry list of compounds for each of the three elements which encompass its components (a) and (b) of its claimed composition. Nothing in Hayakawa "clearly and unequivocally" directs those skilled in the art to specifically select a lactone-modified vinyl monomer with a hydroxyalkyl (meth) acrylate and a lactone polyol having three or more hydroxyl groups. Furthermore, nothing would direct those skilled in the art

to select a polycaprolactone-modified hydroxyalkyl (meth) acrylate such that the average value of the caprolactone repetitive units is between 2 to 3, as in claim 1.

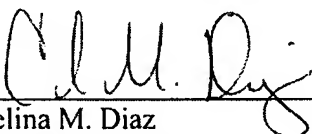
Moreover, “because the hallmark of anticipation is prior invention, the prior art reference-in order to anticipate under 35 U.S.C. § 102-must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). Rather than specifically disclosing the elements of the subject application, Hayakawa discloses combinations of specific amounts of each of its compounds as well as their combination with other specific elements not claimed in Applicants’ independent claim. Applicants do not claim either blocked polyisocyanate compounds or an alkyl etherified melamine resin. Consequently, because Applicants’ composition is not specifically disclosed by Hayakawa and Hayakawa fails to disclose Applicants’ components arranged as they are in claim 1, Applicants respectfully request reconsideration and withdrawal of the rejections made to claims 1, 3-4 and 6-9.

CONCLUSION

It is respectfully urged that the subject application is patentable over the references cited by Examiner and is now in condition for allowance. Applicants request consideration of the application and allowance of the claims. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact Colin P. Cahoon or Celina M. Diaz at 972-367-2001.

The Commissioner is hereby authorized to charge any additional payments that may be due for additional claims to Deposit Account 50-0392.

Respectfully submitted,



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